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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,795	12/24/2003	Masanao Yamagishi	2003_1868A	9804
513	7590	03/15/2006	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P.			WATKO, JULIE ANNE	
2033 K STREET N. W.			ART UNIT	
SUITE 800			PAPER NUMBER	
WASHINGTON, DC 20006-1021			2653	

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/743,795

Applicant(s)

YAMAGISHI ET AL.

Examiner

Julie Anne Watko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/24/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
2. Applicant cannot rely upon the foreign priority papers to overcome any rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the allowable claims are directed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3 and 5-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Luckow (US PAP No. 2002/0139701 A1).

The product by process limitations in these claims (e.g. “cutting”) are directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessman*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this

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issue); *In re Marosi et al*, 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final structure of the product “gleaned” from the process limitations or steps, which must be determined in a “product by process” claim, and not the patentability of the process limitations. Moreover, an old or obvious product produced by a new method is not a patentable product, whether claimed in “product by process” claims or not. Note that the applicant has the burden of proof in such cases, as the above case law makes clear.

As recited in claim 1, Luckow shows an accommodation case 2 of a disk-like recording medium for accommodating a disk-like recording medium, comprising: a main body 4; a cover 3 connected to the main body through a connection portion 5; a receiving table 17 for supporting thereon a disk center portion, formed at a center of the main body in such a fashion as to protrude from a base 4 surface, an outer peripheral edge (including 9) for supporting thereon a disk outer periphery, formed in such a fashion as to protrude with said receiving table as a center; a removable member 9 for supporting an outer periphery of said disk-like recording medium and engaging with the outer periphery; said removable member including a lift portion 22 for supporting thereon the disk outer periphery, formed inside a rocking lever (see rocking arrows in Fig. 4), and a button 23 formed outside said lever; and a hook 18 for engaging with the disk outer periphery, provided to the lever.

As recited in claim 3, Luckow shows a rib 14 fitting to a center hole of said disk is so formed as to erect from said receiving table 17.

Regarding claim 5: See above with respect to product-by-process limitations.

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As recited in claim 6, Luckow shows an accommodating case 2 of a disk-like recording medium for accommodating a disk-like recording medium, comprising: a main body 4; a cover 3 connected to the main body through a connection portion 5; a removable member 9 for supporting an outer periphery of said disk-like recording medium and engaging with the outer periphery, formed on a base 4 of a main body; said removable member including a lift portion 22 for supporting thereon a disk outer periphery, formed inside a rocking lever (see Fig. 4), and a button 23 formed outside said lever; a hook 18 for engaging with the disk outer periphery, provided to said lever; and a member (including 17 and 14, for example) for engaging with a disk center portion or a disk outer periphery, so formed as to erect from a base 4 surface.

Regarding claim 7: See above with respect to product-by-process limitations.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luckow (US PAP No. 2002/0139701 A1).

Luckow shows an accommodating case as described above for claims 1, 3 and 5-7.

As recited in claim 4, Luckow is silent regarding a hook engaging with an inner periphery of the disk center hole is so formed on said receiving table as to erect from said receiving table.

Official notice is taken of the fact that it was known in the art at the time the invention was made to provide a receiving table with a hook engaging with an inner periphery of a disk center hole so as to erect from said receiving table.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a hook to the receiving table of Luckow as is notoriously well known in the art. The rationale is as follows: one of ordinary skill in the art would have been motivated to retain a disk securely upon a receiving table as is notoriously well known in the art.

Allowable Subject Matter

9. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Chiu (US PAP No. 2002/0100701 A1) shows a DVD holding case comprising hooks at an inner diameter (see Fig. 13) and at an outer diameter (see Fig. 8).

Goto et al (US PAP No. 2005/0205441 A1) show a disk containing body (see especially Figs. 10A-C); however, the reference application was filed after Applicant's filing date.

Courchesne (US Pat. No. 6056117) shows a CD carrying case having a pop cover comprising "push-button (30) ... integrally formed by cutting" "for releasably locking the cover shell (34) in the closed position" (see col. 4, lines 11-20).

Lau (US PAP No. 2001/0047947 A1), Chang (US Pat. No. 6016909) and Mendoza et al (US Pat. No. 6454091 B1) show hooks for engaging an inner periphery of a disk.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (571) 272-7597. The examiner can normally be reached on T11A-5P W3P-9P Th11:30A-10P F10A-8:30P SatNoon-8:30P.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Julie Anne Watko
Primary Examiner
Art Unit 2653

March 11, 2006
JAW

A handwritten signature in black ink, appearing to read 'Julie Anne Watko', with a stylized, flowing script.